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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/866,960	05/29/2001	Neil D. Scancarella	Rev 01-6	7403
26807	7590	08/21/2008		
JULIE BLACKBURN REVLON CONSUMER PRODUCTS CORPORATION 237 PARK AVENUE NEW YORK, NY 10017			EXAMINER FUBARA, BLESSING M	
			ART UNIT	PAPER NUMBER
			1618	
			MAIL DATE	DELIVERY MODE
			08/21/2008	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

**Application No.**

09/866,960

**Applicant(s)**

SCANCARELLA ET AL.

**Examiner**

BLESSING M. FUBARA

**Art Unit**

1618

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 17 March 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-4, 7 and 15-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-4, 7 and 15-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/C2)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

The examiner acknowledges receipt of request for continued examination under 37 CFR 1.114, amendment, remarks and exhibit A, all filed 3/17/08 with compliant amended claims further filed 6/10/08. Claims 1 and 7 are amended. Claims 5, 6, and 8-14 are canceled. Claims 1-4, 7 and 15-20 are pending.

#### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 3/17/08 has been entered.

#### ***Response to Arguments***

**Previous rejections that are not reiterated herein are withdrawn.**

#### ***Claim Rejections - 35 USC § 103***

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).
4. Claims 1-4, 7 and 15-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Patil et al. (US 6,342,209) in view of Rokitoski (US 5,750,127).

The amended generic 1 claims is drawn to water and oil emulsion (e.g., water in oil emulsion or oil in water emulsion) which comprises silicone resin film forming polymer; at least one film forming polymer selected from the group consisting of (i) a silicone/acrylate copolymer, (ii) a vinyl/silicone copolymer or a mixture thereof; combination red 40 lake, blue 1 lake, yellow 5 lake and green 5 lake, that when combined achieve a deep brown or black color and such pigments are free from iron oxides. The "when combined achieve deep brown or black color" is the characteristic color that would result when those dyes/pigments are combined.

Patil teaches a cosmetic composition such as a mascara product is made into the form of water-in-oil or oil-in-water emulsion, wherein the mascara contains 0.1-50% water, 0.5-55% oil, 0.1-30% pigment and 0.1-30% of one or more synthetic polymers (e.g., film forming polymers) see col. 12, lines 37-44. In light of Patil's teaching in his disclosure, one or more film forming polymers (synthetic polymers) are present in the composition at from 0.1-95% and the one or more film forming polymers are selected from silicone resins (e.g., trimethylsiloxo

silicate) meeting claims 18-20, silicone/acrylate copolymers and so on, see col. 2, lines 62-col. 3, lines 41 with the silicone/acrylate copolymer meeting claim 1 as it regards to the at least one film forming polymer. US'209 teaches organic pigments to be present at about 0.1-30%, see col. 8, lines 10-29. Furthermore, US'209 teaches silicone oils including volatile cyclic silicone oils (e.g., cyclomethicone present at about 0.5-95%, see col. 6, lines 50-67), and an oil phase comprising dimethicone and isohexadecane or isododecane, (see col.7, lines 26-43) meeting claims 15-18; and 0.1-50% water.

As to the pending claims, all the critical elements required by the instant claims are well taught at col. 8, lines 9-29. For example, US'209 teaches azo, triphenylmethane, anthraquinone, xanthene dyes which are designated as D&C and FD&C blues, browns, greens, oranges, reds, yellows, etc dyes providing generic teaching for the inclusion/presence of blue, yellow, green and red dyes in the composition that has an intended use on mascara.

It is noted that the recitation found in preamble of claim 7 has not been given patentable weight. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, structural limitations are able to stand-alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951). It is noted also that claim 15, which requires Dimethicone having viscosity of 1 centipoise at 20°C, is fully met by Patil because a viscosity of 1 centipoise at 20°C is an inherent property of the composition; and since Patil teaches a composition comprising dimethicone and the other ingredients as described above, the composition of Patil would also inherently have the recited viscosity of 1 centipoise at 20°C.

Thus, the claimed composition is readily envisaged by the skilled artisan from the teachings of Patil.

While Patil contemplates and envisions water and oil compositions comprising blue, yellow, green and red dyes intended for application as mascara, Patil does not specifically teach the specific dyes, that is combination red 40 lake, blue 1 lake, yellow 5 lake and green 5 lake, it is known in the cosmetic formulary art that combination of red 40 lake, blue 1 lake, yellow 5 lake and green 5 lake in a composition is known for application as mascara to eye lashes. For example, Rokitowski teaches color cosmetic formulation for eye lashes such as mascara, the composition contains combination of the dyes, red 40, green 5, yellow 5 and blue 1 (column 1, lines 9, 28-35, 57-67; column 2, line 3; column 3, lines 6-22).

Therefore, taking the teaching of Patil in view of Rokitowski, one having ordinary skill in the art would have reasonable expectation of success that using the specific dyes described by Rokitowski for formulation for the mascara use in the formulation of Patil would provide a formulation that would provide the desired color covering of the eye lashes.

While the color results from the combination of red 40 lake, blue 1 lake, yellow 5 lake and green 5 lake is expected and inherent, it is further noted that it is well within the skilled level of the artisan to mix and adjust the ingredients and processes in order to determine and achieve the most effective outcome results since each critical element required by the instant claims is taught by cited reference and minor variations is prima facie obvious. The techniques and skills required for making such substitution is conventional knowledge or well within the skills of ordinary artisan and thus, obvious, absent evidence to the contrary. Thus, the claimed subject

matter is well within the scope of the patented invention, which renders the claims not patentably distinct over the prior art of the record. All the critical elements are well taught by the cited reference and the claimed invention is properly included in this rejection.

***Response to Arguments***

Regarding *exhibit A*, it is noted that rejection is now made over Patil in view of Rokitoski in view of the current amendments and the color combination is contemplated by the prior art such that the result ensuing from the combination of the colors known to be used in a cosmetic formulation for use as mascara on eyelashes is inherent and expected.

No claim is allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to BLESSING M. FUBARA whose telephone number is (571)272-0594. The examiner can normally be reached on 7 a.m. to 5:30 p.m. (Monday to Thursday).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Hartley can be reached on (571) 272-0616. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Blessing M. Fubara/  
Examiner, Art Unit 1618